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PATENT



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
BOARD OF APPEALS AND PATENT INTERFERENCES**

In re patent application of:

) Attorney Docket No.: E-775

Victor Girardi et al.

) Group Art Unit: 2161

Serial No.: 09/187,907

) Examiner: Calvin L. Hewitt II

Filed: November 06, 1998

) Date: February 25, 2002

Title: METHOD AND APPARATUS FOR DYNAMICALLY LOCATING AND
PRINTING A PLURALITY OF POSTAGE PAYMENT INDICIA ON A
MAILPIECE

BRIEF ON APPEAL

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Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This Appeal Brief, under 37 C.F.R. Section 1.192, is being filed in triplicate together with a Petition for a Two-Month Extension of Time. The Appeal Fee in the amount of \$320.00 and the Two-Month Extension of Time Fee in the amount of \$400.00 in accordance with 37 C.F.R. Sections 1.17(c) and 1.17(a)(2) should be charged to deposit account number 16-1885. If the fees for this appeal are deemed to be insufficient, authorization is hereby given to charge any deficiency (or credit any balance) to deposit account number 16-1885.

REAL PARTY IN INTEREST

The real party in interest is Pitney Bowes Inc. which acquired all rights to the above-identified application by way of an assignment which was recorded in the Assignment Branch of the United States Patent and Trademark Office on November 06, 1998 at Reel 9579 and Frame 0697.

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RELATED APPEALS AND INTERFERENCES

There are no related Appeals or Interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the instant appeal.

STATUS OF CLAIMS

This Application is on Appeal, pursuant to 35 U.S.C. Section 134, from the final rejection of claims 1-15 dated July 25, 2001 and the Advisory Action dated January 18, 2002. The instant application was originally filed with claims 1-9. In the Amendment filed on June 19, 2001 claims 10-15 were added. A response to the final rejection was filed on October 25, 2001, but no changes were made to the claims. Accordingly, claims 1-15 are currently pending and under final rejection and all of claims 1-15 are being appealed.

STATUS OF AMENDMENTS

There are no outstanding amendments in the instant application.

SUMMARY OF THE INVENTION

The instant invention is directed toward a method (claim 1) and apparatus (claim 9) in which a postage metering system (12) creates a document (40) having first (26) and second (66) evidences of postage thereon. The location of the first and second evidences of postage within the document are automatically determined by the postage metering system based on user-selected first and second fold configurations (selected from a plurality of possible fold configurations) as generally described from page 15 line 9 to page 18 line 24 making reference to Figures 2 and 17-19. Since a plurality of fold configurations are possible (see Figures 4-15 and 17-19 which show various C, Z, and half-fold configurations), the instant invention provides for the first time the ability of a postage metering system to dynamically print the first and second evidences of postage within a document at locations dictated by the user-selected first and second fold configurations.

Regarding claim 1, the selecting of the fold configurations and their identification to the postage metering system is discussed at page 17, lines 1-14. The creation of the document, the automatic determination of the locations within the document of the first and second locations for the first and second evidences of postage, and the printing of the document are described at page 16, line 28 to page 18, line 24.

The representative structure associated with claim 9 is as follows: postage metering system 12, user input means 16, accounting means 25, document program 32 running in processor 30, determining means 38, and printing means 18, 43.

ISSUES

At issue in this Appeal is the propriety of the following rejection:

1. Claims 1-15 stand rejected under 35 U.S.C. 103 (a) as being unpatentable over United States Patent No. 5,801,944 (Kara) in view of United States Patent Nos. 5,873,073 (Bresnan), and 5,174,493 (File).

GROUPING OF THE CLAIMS

1. Claims 1, 6, and 9 stand or fall by themselves.
2. Claims 4 and 13 stand or fall together.
3. Claims 5 and 12 stand or fall together
4. Claims 2-3 and 7-8 stand or fall with claim 1 and claims 10-11 and 14-15 stand or fall with claim 9.

ARGUMENTS

Specifically referring to independent claims 1 and 9, the instant invention provides for the first time a postage metering system that has the ability to create and print a document having first and second evidences of postage thereon where the printed locations of the evidences of postage are automatically determined by the postage metering system based on user selected

document fold configurations. As discussed below, none of the cited references teach or suggest providing such a capability in a postage metering system.

As discussed in the background of the invention, the primary reference (Kara) applied by the Examiner only anticipates printing an indicium in the upper right hand corner of a document, as shown for example, in Figure 16B thereof. Kara does not dynamically determine where to print the evidence of postage in a document based on a user-specified fold configuration. Rather, the location of evidence of postage in the document of Kara is assumed to be a fixed parameter at the upper right-hand corner of the document. The specific evidence of printing locations of Figures 6, 8, 11, 17, and 18 of the instant specification are neither taught nor suggested by Kara. It is clear from the Kara reference that it is up to the user to determine how to fold the document subsequent to the printing of the evidence of postage thereon so that it will be visible through the window of the envelope. Kara, therefore, teaches that the predetermined location of the evidence of postage dictates the type fold used and not vice versa.

The Examiner admits that Kara fails to teach or suggest the printing of an evidence of postage within a document based on a user specified fold configuration. Further, Kara only teaches printing of single evidence of postage and does not teach or suggest the printing of the claimed first and second evidences of postage within the document. The Examiner relies on Bresnan for allegedly correcting the deficiencies of Kara. However, the Applicants strongly disagree with the Examiner's interpretations of Bresnan.

Bresnan describes a system that allows a small business to define a mailing job and to download the parameters of the mailing job to a data center that can create, assemble, and produce the finished mailpieces utilizing efficient, high speed systems. Thus, Bresnan eliminates the need for small businesses to acquire expensive high speed mailing equipment since they can utilize a network, such as the Internet, to specify a mailing job to a mailer who subsequently creates the mailing for the small business (see Bresnan column 1, lines 47-52 and column 2, lines 4-9).

Bresnan does discuss a user specified "plurality of characteristics" which define the mailing and that include the document to be printed, a list of addresses to which the documents are sent, a choice of paper type, ink color, paper color, paper size, duplex or simplex printing, a

choice of whether a reply envelope is to be printed, and a choice of how the paper is to be folded (column 2, lines 21-29). These characteristics are transmitted from the user's initiating node 10 and transmitted to the data center node 30 for preparation of the mailpieces defined by the user. The data center node 30 includes a data processor 34, an enveloper printer 38 and a document printer 36 (Figure 1 and column 2, lines 29-33). The document printer 36 will print the document in accordance with the characteristics selected at the initiating node 10 and the address printer 38 will print addresses from the address list to the corresponding envelopes (column 2, lines 33-37).

The Examiner interprets the above language as allegedly teaching that Bresnan shows printing an evidence of postage in the document at a location which is based on a user specified fold configuration. However, such is not the case. Bresnan at column 2, lines 39-49, further states that once the document has been printed, the document is inserted into the envelope by inserting means to form an unfinished mailpiece. The unfinished mailpiece is sealed and then franked in order to form a finished mailpiece. Thus, Bresnan does not even contemplate printing an evidence of postage within the document itself but uses a separate mailing machine 40 to print (frank) postage on the envelope into which the document is placed.

It is submitted that in Bresnan, the specifying of the fold configuration has nothing to do with the placement of an evidence of postage within a document but simply defines the fold to be used at the data center node 30 prior to placing the document into an envelope which is subsequently franked to produce the finished mailpiece. The folding operation would occur either manually or automatically at step 118 of Figure 2 of Bresnan.

The Examiner also admits that neither Bresnan nor Kara teach the claimed first and second evidences of postage that are contained in the document and relies on File for allegedly teaching such concept. The Examiner's position is that File teaches, in Figures 1, 2, 4, 7, and 9, that first and second evidence of postage are included in a single document. However, such is not the case. Rather, File shows a return envelope 11 in Figures 1-4 that has preprinted thereon a place 32 to identify the location of a stamp. Accordingly, any interpretation of Figures 1-4 of File only shows a single evidence of postage. Turning to Figures 7 and 9, Figure 7 shows a conventional Z-fold mailer which has the return envelope 11 inserted therein (Figure

9). Accordingly, File does not teach or suggest a single document having two evidences of postage therein.

It is thus submitted that neither Kara, Bresnan, nor File teach or suggest a method (claim 1) or apparatus (claim 3) in which a postage metering system creates a document having first and second evidences of postage therein. Further, none of the applied references teach or suggest that the location of the first and second evidences of postage within the document are determined by the postage metering system based on user-selected fold configurations that are input to the postage metering system.

Regarding claims 4 and 13 it is also submitted that none of the applied references teach or suggest that the first and second evidences of postage are on opposite sides of the document. This feature permits the use of various type folds as set forth in the application.

Regarding claims 5 and 12 it is also submitted that the applied references do not teach or suggest that the first and second evidences of postage be printed on the same side of a document. This feature permits use of certain fold configurations as set forth in the application.

Claim 6 sets forth that upon folding the first evidence of postage is visible while the second evidence of postage is not. The applied references do not teach or suggest this feature.

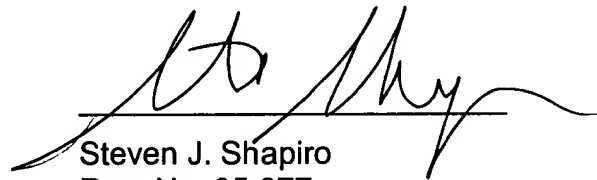
It is also submitted that there is no motivation to combine the references as suggested by the Examiner. None of the applied references even remotely discuss the printing of an evidence of postage in a document based on a user-selected fold configuration let alone two such evidences of postage. The Examiner uses Kara for teaching printing an evidence of postage in a document, Bresnan for teaching determining the placement of an evidence of postage on a document based on the fold configuration and File for the teaching of two evidences of postage printed on a document. Even assuming arguendo that the Examiner's interpretation of the references is incorrect (which, as discussed above, Applicants dispute), there is no teaching or suggestion for combining the references in the manner set forth by the Examiner. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. ***ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).*** The Examiner must be able to point to something in the prior

art that suggests in some way a modification of a particular reference or a combination with another reference to arrive at the claimed invention. Absent such a showing in the prior art, the Examiner has impermissibly used the Applicants' teaching to hunt through the prior art for the claimed elements and combine them as claimed. Such hindsight use of the Applicants' disclosure is improper. *In re Laskowski*, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989). Further, the Examiner's unsupported statements of inherency with respect to certain claim elements are traversed as having no basis in law or in fact.

SUMMARY

It is submitted for each of the reasons enumerated above that claims 1-15 are not rendered obvious in view of the applied references. Accordingly, the Appellants respectfully request that the Board reverse the Examiner with respect to the rejection set forth in the Final Office Action.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'S. Shapiro', is written over a horizontal line.

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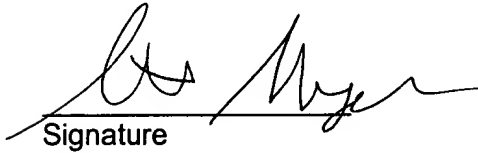
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on February 25, 2002
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Steven J. Shapiro (35,677)
Name of Registered Rep.


Signature

February 25, 2002
Date

APPENDIX A

1. A method of operating a processor based postage metering system having an executable code running on the processor based postage metering system, the executable code operable for controlling creation of a document by a user giving input data to the processor based postage metering system, the method comprising the steps of:

selecting first and second fold configurations for the document from a plurality of possible fold configurations;

identifying to the processor based postage metering system the selected first and second fold configurations;

creating the document within the processor based postage metering system under control of the executable code;

within the processor based postage metering system automatically determining based on the selected first fold configuration a first designated location within the document for printing a first evidence of postage;

within the processor based postage metering system automatically determining based on the selected second fold configuration a second designated location within the document for printing a second evidence of postage; and

printing the document and the first and second evidence of postage such that the first and second evidences of postage are respectively printed in the first and second designated locations of the document.

2. A method as recited in claim 1, wherein the first evidence of postage is one of a postal revenue block and a postage indicia.

3. A method as recited in claim 2, wherein the second evidence of postage is one of a postal revenue block, a postage indicia and a return postage data block.

4. A method as recited in claim 1, wherein the first designated location is on an opposite side of the document from the second designated location.

5. A method as recited in claim 1, wherein the first designated location is on a same side of the document as the second designated location.

6. A method as recited in claim 1, wherein after the printing step the document is folded in a first manner such that the first evidence of postage is visible while the second evidence of postage is not.

7. A method as recited in claim 1, wherein the automatic determination of the first and second designated locations is also based on secondary data.

8. A method as recited in claim 7, wherein the secondary data includes at least one of envelope dimensions including window position, document orientation, fold orientation, and document size.

9. A processor based postage metering system comprising:
means for entering user input data including first and second fold configurations selected from a plurality of fold configurations;
means for accounting for postage dispensed by the processor based postage metering system;
a document program running on the processor based postage metering system, the document program operable for controlling creation of a document based on the user input data;
means for automatically determining based on the first fold configuration a first designated location within the document for printing a first evidence of postage;
means for automatically determining based on the second fold configuration a second designated location within the document for printing a second evidence of postage; and

means for printing the document and the first and second evidences of postage such that the first and second evidences of postage are respectively printed in the first and second designated locations of the document.

10. A processor based postage metering system as set forth in claim 9, wherein the first evidence of postage is one of a postal revenue block and a postage indicia.

11. A processor based postage metering system as set forth in claim 10, wherein the second evidence of postage is one of a postal revenue block, a postage indicia and a return postage data block.

12. A processor based postage metering system as set forth in claim 9, wherein the first and second designated locations are on a same side of the document.

13. A processor based postage metering system as set forth in claim 9, wherein the first and second designated locations are on opposite sides of the document.

14. A processor based postage metering system as set forth in claim 9, wherein the automatic determination of the first and second locations is also based on secondary data.

15. A processor based postage metering system as set forth in claim 14, wherein the secondary data includes at least one of envelope dimensions including window position, document orientation, fold orientation, and document size.